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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Atty. Docket

LAURIE E. GATHMAN

PHUS010499

Confirmation No. 4042

Serial No. 09/971,143

Group Art Unit: 3627

Filed: October 4, 2001

Examiner: Ronald Laneau

Title: SYSTEM AND METHOD FOR SELLING GOODS TO CUSTOMERS OF A
PUBLIC FACILILTY

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Enclosed is an Appeal Brief in the above-identified
patent application.

Please charge the fee of \$500.00 to Deposit Account
No. 14-1270.

Respectfully submitted,

By SRP
Steven R. Petersen, Reg.31,287
Attorney
(914) 333-9640

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TO CUSTOMERS OF A PUBLIC FACILITY

Mail Stop APPEAL BRIEF - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Further to the Notice of Appeal filed on December 8, 2004, applicants submit this brief in support of their appeal of the final office action dated September 8, 2004, rejecting claims 1-20.

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February 8, 2005



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Enclosed is an Appeal Brief in the above-identified patent application. Please charge the fee of \$500.00 to Deposit Account No. 14-1270.

While it is believed that no extension of time is necessary, if one is, please consider this a petition for any required extension, and charge the fee to Deposit Account No. 14-1270.

Respectfully submitted,

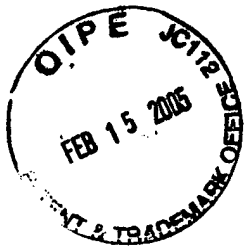
By STR Pet
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of
LAURIE E. GATHMAN et al.

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Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Further to the Notice of Appeal mailed on December 8, 2004 and received on December 10, 2004, Applicants submit this brief in support of their appeal of the final office action dated September 8, 2004, rejecting claims 1-20.

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By: _____

Steven R. Petersen

Date: _____

February 10, 2005

I. REAL PARTY IN INTEREST

The real party in interest is Koninklijke Philips Electronics N.V.

VII. RELATED APPEALS AND INTERFERENCES

There are no prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-20 are pending in the application.

Claims 1-20 are rejected.

Claims 1-20 are appealed.

IV. STATUS OF AMENDMENTS

An amendment under 37 C.F.R. § 1.116 was filed on October 20, 2004. That amendment sought to amend claims 1, 11, and 18 to add the word "program" after the word "application" in order to explicitly set forth an "application program" instead of its well-known shorthand, "application", and to conform these claims to the usage of "application program" in claim 13. The advisory action mailed on November 4, 2004 did not indicate whether the amendment had been entered for purposes of appeal. PAIR indicates that the claim amendment was not entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention is directed to selling goods, at a public facility having an electronic ticket control system, to customers who have a virtual ticket device for storing an electronic ticket.

In one embodiment, the method of independent claim 1, a public-facility electronic ticket control system 400 is provided for communicating with virtual ticket devices 200 through public facility 100 access points AP1-AP8, the virtual ticket devices 200 for storing virtual tickets 350.

(Figs. 1, 3, 4; page 12, lines 10-20; page 15, lines 14-22; page 19, lines 1-3; page 20, line 22 - page 21, line 9; page 24, lines 4-13.) Entry of a virtual ticket device 200 into the area of public facility 100 is detected. (Fig. 7, step 705; page 14, lines 15-21; page 22, line 19 - page 23, line 23; page 28, lines 6-9; page 33, lines 9-16.) An application (214, 434, 620) for use in connection with the electronic ticket control system 400 is downloaded into the virtual ticket device 200. (Page 19, lines 14-17; page 21, lines 2-7, 12-23; page 26, line 20 - page 27, line 18; page 29, lines 10-11; page 29, line 18 - page 30, line 17.) A message is transmitted (step 715) from the electronic ticket control system 400 to the virtual ticket device 200, the message containing information relating to goods available for sale at the public facility. (Fig. 7; page 31, line 19 - page 32, line 3; page 33, line 18 - page 34, line 3.)

In another embodiment, the system of independent claim 13, a system for selling goods to virtual ticket device 200 users in a public facility 100 comprises an electronic ticket control system 400 (Figs. 4, 6; page 24, line 4 - page 27, line 18; page 29, line 1 - page 32, line 19); at least one access point (AP1 - AP8) through which the electronic ticket control system 400 may communicate with a virtual ticket device 200 (page 15, lines 14-22); a sales database (part of 415) containing information relating to goods for sale at the public facility 100 (page 33, lines 5-8); a processor 410 in communication with the sales database 415 containing goods-related information for sending to the virtual ticket device 200 through the at least one access point AP (Fig. 7, steps 710, 715; page 33, line 18 - page 34, line 3); and an application program (214, 434, 620) for downloading to the virtual ticket device 200 and subsequent use in connection with the electronic ticket control system 400. (Page 19, lines 14-17; page 21, lines 2-7, 12-23; page 26, line 20 - page 27, line 18; page 29, lines 10-11; page 29, line 18 - page 30, line 17.)

In another embodiment, the method of independent claim 18, in addition to the elements described above with respect to claim 1, the goods-related message transmitted from electronic ticket control system 400 to virtual ticket device 200 is transmitted in response to an occurrence at the event and the goods offered for sale are specifically related to the occurrence. (*Page 32, lines 4-7.*)

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1-10, 13-15 and 19-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application Publication No. 2001/0018660 A1 to Sehr ("Sehr").

B. Claims 11-12 and 16-18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sehr.

VII. ARGUMENT

A. The § 102 Rejection

The September 8, 2004 office action rejected Claims 1-10, 13-15 and 19-20 under 35 U.S.C. § 102(e) as being anticipated by Sehr. This rejection was improper for the following reasons.

A prior art reference anticipates the claimed invention under 35 U.S.C. §102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; In re Donohue, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Although Sehr discloses an electronic ticketing system having some elements of the claimed invention, Sehr fails to disclose a downloaded application program¹ as claimed in independent claims 1 and 13 in the following language:

¹ It is well known that "application" is a shorthand for and means "application program". Although the clarifying Rule 116 amendment was not entered, it is submitted that "application" in claim 1 means "application program".

downloading into the virtual ticket device an application for use in connection with the electronic ticket control system (claim 1);

an application program for downloading to the virtual ticket device and subsequent use in connection with the electronic ticket control system (claim 13).

The Sehr reference describes an electronic ticketing system that includes a visitor card onto which may be loaded information and data such as seat assignments [0048], monetary values and electronic payment forms [0049], electronic tickets [0051], entrance and exit stamps [0052]. The visitor cards may be so-called "smart" cards, "handheld terminals or any pocket sized computer configurations" [0035].

The ground for rejection of claims 1 and 13 relies on Sehr [0113] as disclosing the claimed downloaded application. Sehr [0113] states:

[0113] After verifying the service codes and qualifying the cardholder, services identified by those codes can be rendered to that cardholder. The card can now be used to receive the appropriate services facilitated via the card. For example, to order services and to purchase selected merchandises, pay for the services and goods via the visitor card, communicate with the seating map and other system databases, download data and information to be stored in the card, and to accumulate appropriate bonus points to be used for future services and consumptions. (Emphasis added.)

The only portion of Sehr [0113] disclosing downloading is "download data and information to be stored in the card." An application program is different from "data and information," and the terms are distinguished in applicants' specification (see page 21 lines 2-23, where downloaded applications such as venue applications 214 are distinguished from downloaded data files such as venue data files 215). A word search in Sehr reveals that all instances of "download" relate to downloading of data and information, and not to downloading of application programs. A word search in Sehr reveals that no instances of "application," "program," or "software" relate to downloading of application programs. Sehr simply does not disclose the downloaded application element of claims 1 and 13, and the rejection under 35 U.S.C. § 102 was improper.

B. The § 103 Rejection

The September 8, 2004 office action rejected claims 11-12 and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Sehr. This rejection was improper for the following reasons.

All claims dependent on claims 1 and 13 include the downloaded-application element that is not found in the cited reference. Therefore, claims 2-12, 14-17, and 19-20 are patentable for the reasons stated above with respect to claims 1 and 13.

Independent claim 18 includes all of the elements of claim 1, and therefore it also is patentable because Sehr does not disclose downloading an application to a virtual ticket device.

Claim 18 includes an additional clause that does not appear in claim 1, namely:

wherein the step of transmitting a message transmits a message in response to an occurrence at the event and the goods offered for sale are specifically related to the occurrence.

The example given in the application, at page 32, lines 4-7, is that in response to a home run by a player, a message is transmitted to virtual ticket devices advertising the availability of T-shirts featuring that player. The examiner relied on official notice of two alleged facts to supply this element. It is respectfully submitted that, even if the alleged facts were true and it were proper under MPEP § 2144.03 to notice them, the facts would not satisfy the additional claim language set forth above. At page 8 of the final office action, the examiner took official notice that movies that have an intermission use advertisements to sell snacks and beverages to movie watchers, and claimed that snacks and beverages are specifically related to the intermission break and what a person can do with it. Snacks are sold and consumed continuously before, during, and after movies, and intermissions can be used for any activity the moviegoer chooses; they bear no particular relationship to each other. Moreover, the examiner did not assert that snack/beverage ads are presented in response to the occurrence of an intermission. If the examiner took official notice that it was common for a

theater to present a snack or beverage ad in response to the occurrence of a movie scene where the actors ate or drank, that might satisfy the claim element. But such is not what the examiner asserted, and the examiner's movie example does not satisfy the claim limitation.

The examiner also took official notice that "during concerts, performers will sing a song from their new album and an advertisement or a vocal message telling the patrons that the new album is available for sale at the concession is made ... The song sang is specifically related to the album for sale." The examiner did not assert that such advertisement or vocal messages are made in response to the occurrence of the singing of a song. And people don't "respond" to their own actions; a singer's pitch to sell albums would hardly be considered as being made in response to the singer's action in singing the song.

The examiner also rejected claims 11 and 16 under 35 U.S.C. § 103(a) on the basis of official notice of "facts" that allegedly supplied the additional element in these dependent claims, namely, wherein the downloaded application program comprises a user-interface program for use in connection with the purchase of public-facility goods. The examiner noted that Sehr discloses that his visitor cards 11 might be a handheld terminal or a pocket computer. The examiner then took official notice that certain commercially available handheld terminals / pocket computers "require specialized software and user interfaces particularly when utilizing biometrics and cryptography." Assuming that is true, what the examiner did not state is that the commercially available handheld terminals / pocket computers obtain such required user interface programs by downloading them. And that is what the claim requires.

The Examiner stated that "[t]hus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have had the electronic ticket control system of Sehr include a downloadable user-interface program in order to ensure that the handheld terminals or any pocket-

sized computer configurations would function with the system and method.” (September 8, 2004 office action, page 6, line 24 - page 7, line 3). Applicants respectfully submit that there is no teaching or suggestion in the prior art or motivation to combine a downloadable user-interface program with the Sehr system.

In order to establish obviousness by combining references or modifying references there must be some teaching or suggestion in the prior art to combine or modify the references. Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) (“It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.”); In re Rouffet, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). In re Roufett, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

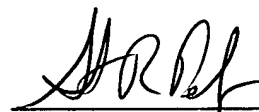
It is respectfully submit that the alleged motivation to modify the Sehr reference presented by the examiner does not meet the legal requirement to establish a finding of prima facie obviousness.

The alleged motivation to modify the Sehr reference is not clear and particular. The Sehr reference is silent concerning the addition of a downloaded user-interface application program to the Sehr system. The examiner's allegation of some need in handheld terminals and pocket-sized computer for "specialized software and user interfaces particularly when utilizing biometrics and cryptography" does not, without more, provide a "clear and particular" motivation to modify the Sehr reference to add a downloadable user interface program to the Sehr system. Applicants respectfully submit that the alleged motivation to modify the Sehr reference has been assumed by "hindsight" in light of the existence of the Applicants' invention.

C. Conclusion

For the foregoing reasons, Applicants request that the Board reverse the rejection of claims 1-20.

Respectfully submitted,



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VIII. CLAIMS APPENDIX

1. A method of doing business, comprising:
providing a public-facility electronic ticket control system for communicating with virtual ticket devices through public-facility access points, the virtual ticket devices for storing virtual tickets;
detecting when a virtual ticket device has entered the public-facility area;
downloading into the virtual ticket device an application for use in connection with the electronic ticket control system; and
transmitting a message from the electronic ticket control system to the virtual ticket device, the message containing information relating to goods available for sale at the public facility.
2. The method of doing business of claim 1, further comprising the step of receiving in the electronic ticket control system a responsive message relating to goods available for sale at the public facility.
3. The method of doing business of claim 2, further comprising the step of concluding a sale of goods.
4. The method of doing business of claim 3, further comprising the step of delivering the purchased goods to the virtual ticket device user.
5. The method of doing business of claim 4, wherein the delivery of goods is at a specific location in the public facility where the virtual ticket device is located at the time of delivery.
6. The method of doing business of claim 5, wherein the electronic ticket control system includes a virtual ticket device locator program that determines the specific location within the public facility where the goods should be delivered.
7. The method of doing business of claim 3, further comprising the step of storing information related to the concluded sale in a database.
8. The method of doing business of claim 7, wherein the content of the message containing information relating to goods available for sale is determined at least in part by information in the database relating to at least one previously concluded sale.
9. The method of doing business of claim 8, wherein the information in the database relates to at least one sale previously concluded through the virtual ticket device.
10. The method of doing business of claim 1, wherein the content of the message containing information relating to goods available for sale is determined at least in part by the admission privileges associated with an electronic ticket stored on the virtual ticket device.
11. The method of doing business of claim 1, wherein the downloaded application includes a user-interface program.

12. The method of doing business of claim 1, further comprising the step of sending an image representing goods for sale at the public facility to the virtual ticket device.

13. A system for selling goods to virtual ticket device users in a public facility, comprising:

- an electronic ticket control system;
- at least one access point through which the electronic ticket control system may communicate with a virtual ticket device;
- a sales database containing information relating to goods for sale at the public facility;
- a processor in communication with the sales database containing goods-related information for sending to the virtual ticket device through the at least one access point; and
- an application program for downloading to the virtual ticket device and subsequent use in connection with the electronic ticket control system.

14. The system of claim 13, further comprising a sales control program for directing the processor to generate a goods-related message for transmission.

15. The system of claim 13 further comprising a virtual ticket device locator program for determining the specific location of a virtual ticket device in the public facility.

16. The system of claim 13, wherein the application program comprises a user-interface program for use in connection with the purchase of public-facility goods.

17. The system of claim 13, further comprising an image file database containing electronic image data relating to public facility goods for transmitting to a virtual ticket device.

18. A method of doing business, comprising:
providing a public-facility electronic ticket control system for communicating with virtual ticket devices through public-facility access points, the virtual ticket devices for storing virtual tickets;

- detecting when a virtual ticket device has entered the public-facility area;
- downloading into the virtual ticket device an application for use in connection with the electronic ticket control system; and

- transmitting a message from the electronic ticket control system to the virtual ticket device, the message containing information relating to goods available for sale at the public facility, and wherein the step of transmitting a message transmits a message in response to an occurrence at the event and the goods offered for sale are specifically related to the occurrence.

19. The method of doing business of claim 1, further comprising the step of identifying a group of virtual ticket devices having virtual tickets with a shared characteristic, wherein the message containing information relating to goods available for sale is transmitted to the identified group of virtual ticket devices.

20. The method of doing business of claim 1, further comprising the step of identifying a group of virtual ticket devices having virtual tickets with a shared characteristic, wherein the content of the message containing information relating to goods available for sale is determined at least in part by information relating to the shared characteristic.